

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MATTHEW ROZEK and BART FULLER

Appeal No. 2007-1235
Application No. 09/748,125
Technology Center 2100

Decided¹: July 31, 2007

Before HUBERT C. LORIN, LINDA E. HORNER, and
ANTON W. FETTING, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from a decision of the Examiner rejecting claims 1-22. 35 U.S.C. § 134 (2002). We have jurisdiction under 35 U.S.C. § 6(b) (2002).

¹ An oral hearing was conducted on June 6, 2007.

The invention is directed to a computer-implemented process (claims 1 and 18), electronic commerce system (claim 19), and computer program product (claim 20) for translating documents received from trading partners in one format into another compliance-validated format to be sent to other trading partners. Specification, p. 5, ll. 9-24. The translation process includes capturing translation errors in a tracking database. Specification, p. 5, ll. 24-25. The translation process also includes extracting data from the document being translated for use as an identifier in the tracking database. The identifier is saved in the database as an index for the error data. Specification, p. 5, ll. 25-28.

The claims are rejected as follows:

- Claims 1-2, 6-7, and 11-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ricker ("XML and EDI- Peaceful Co-Existence," 3 March 2000, available from www.archive.org) and further in view of Puckett (US 5,572,670).
- Claim 3 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ricker and Puckett, and further in view of Dysart (US 6,708,166), and further in view of Casper (US 5,526,484).
- Claim 4 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ricker, Puckett, Dysart, and Casper, and further in view of Dowling (US 6,157,988).
- Claims 5 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ricker and Puckett, and further in view of Casper.
- Claim 8 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ricker and Puckett, and further in view of Rusterholz et al. (US 4,945,479).
- Claim 9 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ricker and Puckett, and further in view of Loebig (US 5,406,563).
- Claim 10 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ricker, Puckett, Loebig, and further in view of Casper.

- Claims 21-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ricker and Puckett, and further in view of Yang (US 6,530,039).

We AFFIRM.

Appellants, in the Appeal Brief², argue the claims in accordance with the following groups:

- claims 1-10 and 13-20 (Appeal Br. 6-7);
- claims 11 and 12 (Appeal Br. 7); and,
- claims 21 and 22 (Appeal Br. 7-8).

Claims 1-2, 6-7, and 13-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ricker and further in view of Puckett.

Because Appellants argue claims 1-10 and 13-20 as a group, pursuant to the rules, the Board selects representative claim 1 to decide the appeal with respect to this rejection, and claims 2, 6-7, and 13-20 will stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2006). Claim 1 reads as follows:

1. A computer implemented process for tracking inbound documents received from trading partners in a business-to-business electronic commerce system, the process comprising the steps of:
 - (a) receiving an inbound document from a trading partner at a translator;
 - (b) the translator checking compliance of the document for translation from a source format to a desired target format;
 - (c) attempting translation of the document, and capturing error data representing errors detected in the translation to a tracking database; and

² Our decision will make reference to Appellants' Appeal Brief ("Appeal Br.," filed Jun. 26, 2006), the Examiner's Answer ("Answer," mailed Aug. 23, 2006), and to the Reply Brief ("Reply Br.," filed Oct. 19, 2006).

(d) extracting data from the received inbound document from the trading partner and using it to provide an internal document identifier, and saving the internal document identifier to the tracking database as an index for the error data, said internal document identifier correlated to the received inbound document from the trading partner.

A. Issue

The issue is whether Appellants have shown that the Examiner erred in holding the combination of Ricker's computer-implemented e-business process facilitating exchange of information between traders using different formats through the translation of inbound documents from one format to another with Puckett's recording of errors in an error log database as part of an error data translation system would have rendered the subject matter of claim 1 obvious to one of ordinary skill in the art at the time of the invention.

Appellants contend that Ricker and Puckett do not teach or disclose:

(1) "on attempting translation of the document, error data detected in the translation are captured to a tracking database" (Appeal Br. 6) [i.e., step (c) of claim 1], and

(2) "an internal document identifier is saved to the tracking database that servers [sic, serves] as an index for the translation error data" (Appeal Br. 6) [i.e., step (d) of claim 1]. Emphasis original.

The Examiner contends that Ricker and Puckett would have rendered the subject matter of these steps obvious to one of ordinary skill in the art.

Answer 3-4.

The issue is whether Appellants have shown that the Examiner erred in holding the combination of Ricker and Puckett would have rendered the

subject matter of steps (c) and (d) of claim 1 obvious to one of ordinary skill in the art at the time of the invention.

B. Findings of Fact

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. The Examiner found that:

As per independent claim 1, Ricker discloses a computer implemented process for tracking inbound documents received from trading patterns [sic, partners] in a business-to-business electronic commerce system, the process comprising:

- (a) Receiving an inbound document from a trading partner at a translator (Figure 9)
- (b) The translator checking compliance of the document for translation from a source format to a desired target format (Figure 9)
- (c) Attempting translation of the document and detecting errors in the translation (page 8: Here, the translation is performed using an X12 dictionary. The translation is then checked to ensure that the data is complete and accurate).

Answer 3-4. Accordingly, the Examiner found that Ricker shows steps (a), (b), and that part of step (c) which calls for “attempting translation of the document.” Appellants did not traverse these findings by the Examiner. Appeal Br. 6-7. Thus Ricker shows a computer implemented process comprising the steps of (a) receiving an inbound document from a trading partner at a translator; (b) the translator checking compliance of the document for translation from a source format to a desired target format; and (c) attempting translation of the document.

2. Appellants argued that “[t]he final office action [wrongly] states that Ricker discloses [the] feature [of capturing error data detected in the

translation to a tracking database] and cites figure 9 and page 8 of Ricker.” Appeal Br. 6. However, we can find no indication in the record that the Examiner found Ricker to show *capturing* error data. Instead, the Examiner relied on Figure 9 of Ricker to show a translator receiving an inbound document from a trading partner and translating it from a source format to a compliant target format. Furthermore, the Examiner conceded that Ricker “fails to specifically disclose … [c]apturing data errors to a database.”

Answer 4.

3. Rather than stating that Ricker discloses *capturing* error data, the Examiner stated that Ricker’s “process of validating the document inherently *detects* errors if the document is not ‘well-formed.’” Answer 14. Appellants do not traverse this finding. Appeal Br. 6-7 and Reply Br. 1-2.

4. The Examiner found that

Puckett discloses:

- Capturing data errors to a database (column 2, lines 60-67).

Answer 4.

5. Appellants do not traverse the Examiner’s finding that Puckett teaches capturing error data in a database. Appeal Br. 6-7.

6. Appellants dispute the *relevance* of Puckett, arguing that Puckett relates to a translator that translates low level error data (for example, binary records) stored in an error database to a more intelligible form and correlates higher level queries to the lower level error data stored in the error log database 168.. The error data stored in the error log database is derived from system log files in a mass storage system. See col. 2, lines 17-20 and col. 3, lines 4-12 of Puckett.

Appeal Br. 6. Puckett’s relevance is disputed on the grounds that “the error processing in Puckett has nothing to do with the (1) claimed capturing of *translator error data* in a tracking database that represents errors in inbound

document which are detected in the translation process,” Appeal Br. 6. Emphasis original. In other words, Appellants dispute the relevance of Puckett on the grounds that, although Puckett captures errors to a database, the captured errors are not, as in claim 1, translation errors.

7. The Examiner also found that

Puckett discloses:

...

- Extracting data from the received document and using it to provide a document identifier, and saving the document identifier to a database as an index for the error data, the document identifier correlated to the received document (column 3, lines 4-12: Here, the header is a document identifier grouping the error events).

Answer 4.

8. Appellants do not traverse the Examiner’s finding that Puckett teaches providing a document identifier and saving the document identifier as an index for the error data correlated to the received document. Appeal Br. 6-7.

9. Instead, Appellants dispute the *relevance* of Puckett, arguing that “Puckett has nothing to do with an inbound trading partner document,” Appeal Br. 7, and thus “necessarily does not teach or suggest anything related to (2) an internal document identifier being saved to the tracking database that serves as an index for the translation error data” (Appeal Br. 7). In other words, Appellants dispute the relevance of Puckett on the grounds that, although Puckett provides a document identifier and saves the document identifier as an index for the error data correlated to the received document, it is not directed to inbound trading partner documents.

10. Ricker discloses a translator which uses a data dictionary (i.e., X12) to transform a message from one format to another “well-formed” one. P. 8, l. 6.
11. Ricker indicates that, in the case of converting documents in XML to EDI, the “X12 data dictionaries will ensure the XML document is *compliant* with a well-formed EDI message.” P. 8, l. 6.

C. Principles of Law

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). *See also KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 18, 148 USPQ at 467.

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior

art,” *id.* at 1739, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious.

In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S.Ct. at 1739, 82 USPQ2d at 1395 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966) (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740, 82 USPQ2d at 1396. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Supreme Court made clear that “[f]ollowing these principles may be more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement.” *Id.* The Court explained, “[o]ften, it will be

necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *Id.* at 1740-41, 82 USPQ2d at 1396. The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.*, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

D. Analysis

The patentability of claim 1 under 35 U.S.C. § 103(a) (2002) depends on whether the claimed subject matter is obvious over Ricker and Puckett.

The Examiner found that Ricker shows a computer implemented process comprising the steps of (a) receiving an inbound document from a trading partner at a translator; (b) the translator checking compliance of the document for translation from a source format to a desired target format; and (c) attempting translation of the document. FF 1.

Appellants did not traverse these findings by the Examiner (FF1), arguing instead that the Examiner wrongly found that Ricker shows

capturing error data detected in the translation to a tracking database (FF 2). That argument has no merit since we find nothing in the record to indicate that the Examiner made such a finding. FF 2.

Rather, the Examiner found that Ricker's "process of validating the document inherently *detects* errors if the document is not 'well-formed.'" FF 3. Appellants did not traverse this finding. FF 4. Furthermore, this finding is in accord with a person of ordinary skill in the art's understanding of what Ricker discloses. See FF 10 and 11. To one of ordinary skill in the art, ensuring the XML document is *compliant* with a well-formed EDI message suggests the document has been translated without errors in translation which, if they were present, would render it non-compliant. An ability to detect these errors would be a necessary precondition to achieving a translated document that is "compliant with a well-formed EDI message."

Accordingly, we find that Ricker shows a computer implemented process comprising the steps of (a) receiving an inbound document from a trading partner at a translator; (b) the translator checking compliance of the document for translation from a source format to a desired target format; and (c) attempting translation of the document, which translation involves detecting errors.

The Examiner found that Puckett discloses "capturing data errors to a database (column 2, lines 60-67)" and "[e]xtracting data from the received document and using it to provide a document identifier, and saving the document identifier to a database as an index for the error data, the document identifier correlated to the received document (column 3, lines 4-12: Here, the header is a document identifier grouping the error events)." FF 4 and 7.

Appellants did not traverse these findings of the Examiner. FF 5 and 8.

Accordingly, we find that Puckett shows capturing data errors to a database and extracting data from the received document and using it to provide a document identifier, and saving the document identifier to a database as an index for the error data, the document identifier correlated to the received document. Puckett therefore appears to show the subject matter set forth in steps (c) and (d) of claim 1.

As to the subject matter of step (c) of claim 1, Appellants argued that Puckett is not relevant because it does not show capturing error data “that represents errors in *inbound documents* which are detected in the translation process,” FF 6. This argument is unpersuasive.

Step (c) requires “capturing error data *representing errors detected in the translation* to a tracking database.” An argument that the error data to be captured represent errors in *an inbound document* is not commensurate in scope with what is claimed.

Furthermore, the Examiner did not rely on Puckett to show capturing error data *representing errors detected in the translation* to a tracking database. The Examiner relied on Puckett to show as known a step of capturing errors. It is Ricker which has been relied upon for detecting errors in the translation of inbound documents. As already explained, one of ordinary skill in the art reading Ricker would understand that in practicing the Ricker process, translating an inbound document such that it is compliant with a well-formed outbound document necessarily involves detecting errors. The Examiner took the position that the combination of Ricker and Puckett would lead one of ordinary skill in the art to detect errors in

translation (per Ricker) and capture those errors in a tracking database (per Puckett).

Finally, to the extent that Appellants argued that Puckett is not relevant prior art on the grounds that it does not involve inbound documents, we disagree. The use of error log files as a means for capturing errors is notoriously well known and Puckett is an example where it can be usefully employed. Error log files provide information about error types and their frequency, which is helpful in improving a system. One of ordinary skill in the art reading Puckett would understand that the error log files are used to improve the Puckett system but have a much wider applicability.

Appellants also argued that “Puckett has nothing to do with an inbound trading partner document,” (FF 9) with respect to whether Puckett is relevant to showing the subject matter of step (d) of claim 1. Here, too, we do not agree.

Appellants did not traverse the Examiner’s finding that Puckett teaches providing a document identifier and saving the document identifier as an index for the error data correlated to the received document (FF 8). Accordingly, Appellants are only arguing that a patentable distinction exists in the claim defining a *source* for the data used to identify the error captured in the database that is different from the one Puckett discloses (i.e., an inbound document versus Puckett’s events occurring in the data storage system). However, the information used by Puckett to represent errors in the storage system captured in the error log database is itself data, and, as such, is not functionally different from data obtained from any another source for identifying information to represent errors in a log database. Furthermore, there is no indication in Puckett that the data used to represent error data in a

log database is uniquely dependent on the presence of a storage system. One of ordinary skill in the art reading Puckett would understand Puckett to be describing a particular application for identifying the errors captured in the log database and that such a step would be useful to identify errors wherever errors are detected and captured in log databases. Accordingly, we are not persuaded by the argument that Puckett is not relevant to the subject matter claimed in step (d).

We have addressed all of Appellants' arguments and find them unpersuasive as to find fault with the Examiner's characterization of the scope and content of Ricker and Puckett.

Based on an analysis of the scope and content of Ricker and Puckett, the facts support the conclusion that Ricker shows a computer implemented process comprising the steps of (a) receiving an inbound document from a trading partner at a translator; (b) the translator checking compliance of the document for translation from a source format to a desired target format; and (c) attempting translation of the document, which translation involves detecting errors, and that Puckett shows (c) capturing error data to a tracking database; and (d) extracting data from a received document and using it to provide a document identifier, and saving the document identifier to a database as an index for the error data, the document identifier correlated to the received document. Accordingly, all of the steps and their limitations are disclosed in the prior art. We find each step claimed performs as one of ordinary skill in the art would expect it to perform from reading the cited prior art. Each performs a known function and that function is spelled out in the prior art. The steps claimed do no more than what one would expect if the steps described in Ricker and Puckett were to be combined. "The

combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1739, 82 USPQ2d 1385, 1395 (2007). In that regard, Appellants have not shown that the claimed method yields an unexpected result.

E. Conclusion of Law

On the record before us, Appellants have failed to show that the Examiner erred in rejecting the claims over the prior art.

Claim 3 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ricker and Puckett, and further in view of Dysart, and further in view of Casper).

Claim 4 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ricker, Puckett, Dysart, and Casper, and further in view of Dowling.

Claims 5 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ricker and Puckett, and further in view of Casper.

Claim 8 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ricker and Puckett, and further in view of Rusterholz et al..

Claim 9 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ricker and Puckett, and further in view of Loebig.

Claim 10 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ricker, Puckett, Loebig, and further in view of Casper.

Claims 3-5 and 8-10 are separately rejected under 35 U.S.C. § 103 over Ricker and Puckett and other references as set forth in these statements of the rejections. Appellants, however, provide no separate argument with respect to any of these rejections but, rather, state that claims 3-5 and 8-10 stand or fall as part of the group that includes claims 1-2, 6-7, and 13-20

addressed above and for which claim 1 was designated as representative. Appeal Br. 6-7. We therefore do not separately address the rejections of claims 3-5 and 8-10 but, rather, consider them to stand or fall with the disposition of the rejection of claim 1. Since we have found that Appellants have failed to show that the Examiner erred in rejecting claim 1, we likewise find that Appellants have failed to show that the Examiner erred in rejecting claims 3-5 and 8-10.

Claims 11 and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ricker and further in view of Puckett.

Claims 11 and 12 read as follows:

11. A process as claimed in claim 1, wherein the step (d) comprises extracting data from both a document's enveloping information and from within the document.

12. A process as claimed in claim 1, wherein error data is captured by writing values to variables in memory, and subsequently saving said values to the tracking database referenced to the internal document identifiers.

A. Issue

The issue is whether Appellants have shown that the Examiner erred in holding the combination of Ricker's computer-implemented e-business process facilitating exchange of information between traders using different formats through the translation of inbound documents from one format to another with Puckett's recording of errors in an error log database as part of an error data translation system would have rendered the subject matter of claims 11 and 12 obvious to one of ordinary skill in the art at the time of the invention.

B. Findings of Fact

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. We incorporate herein the facts under the Findings of Fact section for the rejection of claims 1-2, 6, 7, and 13-20 above and add the following facts.
2. Claim 11 further limits the data extracting step of step (d) of claim 1 to include "extracting data from both a document's enveloping information and from within the document."
3. The Examiner found

As per dependent claim 11, Ricker and Puckett disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Puckett further discloses that step d) comprises extracting data from both a document's enveloping information and from within the document (col. 3, lines 5-7, "These events can be errors in the storage system or simply routine observations about the storage system").

Answer 6.

4. Appellants did not traverse the Examiner's finding but rather question its relevance to the claimed subject matter, arguing that:

[t]he office action states with respect to the features of claim 11, that "these errors can be errors about the storage system or simply routine observations about the storage system." However, equating the errors related to the "storage system" to the claimed document information is incorrect since one skilled in the art of either computing systems or e-commerce systems would not equate a trading partner document to a storage system disclosed by Puckett.

Appeal Br. 7.

5. Claim 12 further limits the error data capture to writing values to variables in memory and saving those values to the tracking database referenced to the internal document identifiers.

6. The Examiner found

As per dependent claim 12, Ricker and Puckett disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Puckett further discloses a process wherein error data is captured by writing values to variables in memory, and subsequently saving said values to the tracking database referenced to the internal document identifiers (Fig. 3, items 308-316, Fig 3 details how tuples are stored in a metalanguage (which must occur in variables), then outputted to a database).

Answer 6.

7. Appellants traversed the Examiner's findings by arguing the following:

[T]he rejection of claim 12 does not indicate how translation errors in trading partner documents are correlated to variables and stored referenced to the internal document identifiers (which are not disclosed by any of the applied references).

Appeal Br. 7.

C. Principles of Law

We incorporate herein the principles of law under the Principles of Law section for the rejection of claims 1-2, 6, 7, and 13-20 above.

D. Analysis

Appellants' arguments are unpersuasive in showing error in the Examiner's findings.

As to the Examiner's finding with respect to the subject matter of claim 11 (FF 3), Appellants did not traverse the substance of the finding that

led the Examiner to conclude that Puckett discloses extracting data from both a document's enveloping information and from within the document. Appellants argue instead that

equating the errors related to the "storage system" to the claimed document information is incorrect since one skilled in the art of either computing systems or e-commerce systems would not equate a trading partner document to a storage system disclosed by Puckett.

FF 4. We disagree.

One of ordinary skill in the art reading Puckett would not conclude that the process therein for extracting data is limited in application to the system Puckett describes. The disclosure in col. 3, lines 5-7 of Puckett, which the Examiner relies upon, describes capturing errors in an error log database. While the errors being captured are related to events occurring in the storage system, the mechanism by which Puckett captures errors (i.e., using an error log database represented by headers or descriptors) does not depend on the types of errors to be captured. Furthermore, the issue is not whether Puckett anticipates the subject matter of claim 11 but whether the combination of Ricker and Puckett would have led one of ordinary skill in the art to the subject matter of claim 11 such that it would have been obvious under 35 U.S.C. § 103(a) (2002). Finally, Puckett's disclosure is clearly relevant to the subject matter claimed because Puckett captures errors in a tracking database, a step which the claimed method also performs.

As to the Examiner's finding with respect to the subject matter of claim 12 (FF 6), Appellants did not traverse the substance of the finding that led the Examiner to conclude that Puckett discloses a process wherein error data is captured by writing values to variables in memory, and subsequently

saving said values to the tracking database referenced to the internal document identifiers. Appellants argue instead that:

the rejection of claim 12 does not indicate how translation errors in trading partner documents are correlated to variables and stored referenced to the internal document identifiers (which are not disclosed by any of the applied references).

FF 7. In other words, Appellants object to Puckett's relevance to claim 12 on the grounds that it does not involve trading partner documents.

Appellants' argument is unpersuasive to show error in the Examiner's finding because, as with the argument regarding the rejection of claim 11, the issue is not whether Puckett anticipates the subject matter of claim 12 but whether the combination of Ricker and Puckett would have led one of ordinary skill in the art to the subject matter of claim 12 such that it would have been obvious under 35 U.S.C. § 103(a) (2002). Furthermore, Puckett's disclosure is clearly relevant to the subject matter claimed because Puckett not only captures errors in a tracking database but also identifies the errors captured, steps which are also present in the claimed method.

Having found Appellants' arguments on the relevance of Puckett unpersuasive, we find that Appellants have not shown error in the *prima facie* case of obviousness. Each step claimed performs as one of ordinary skill in the art would expect it to perform from reading the cited prior art. Each performs a known function and that function is spelled out in the prior art. The steps claimed do no more than what one would expect if the steps described in Ricker and Puckett were to be combined. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1739, 82 USPQ2d 1385, 1395 (2007). In that regard,

Appellants have not shown that the claimed method yields an unexpected result.

E. Conclusion of Law

On the record before us, Appellants have failed to show that the Examiner erred in rejecting the claims over the prior art.

Claims 21-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ricker and Puckett, and further in view of Yang.

Claims 21 and 22 read as follows:

21. The process as claimed in claim 1, further comprising the step of using the internal document identifier to identify translation error data corresponding to the inbound document from the trading partner and provide information to the trading partner based on the identified translation error data.

22. The computer program product as claimed in claim 20, configured for further performing the step of using the internal document identifier to identify translation error data corresponding to the inbound document from the trading partner and provide information to the trading partner based on the identified translation error data.

A. Issue

The issue is whether Appellants have shown that the Examiner erred in holding the combination of Ricker's computer-implemented e-business process facilitating exchange of information between traders using different formats through the translation of inbound documents from one format to another with Puckett's recording of errors in an error log database as part of an error data translation system would have rendered the subject matter of

claims 21 and 22 obvious to one of ordinary skill in the art at the time of the invention.

B. Findings of Fact

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. We incorporate herein the facts under the Findings of Fact section for the rejection of claims 1-2, 6, 7, and 13-20 above and add the following.
2. The Examiner found that

As per dependent claim 21, Ricker and Puckett disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Ricker and Puckett fail to specifically disclose the step of identifying error data corresponding to the inbound document from the trading partner and provide information to the trading partner based on the identified error data. However, Yang discloses identifying error data corresponding to the inbound document from the trading partner and provides information to the trading partner based on the identified error data (column 9, table: Here, if a translation fails, an error message is generated informing a user that the translation does not work).

...

As per dependent claim 22, the applicant discloses the limitations similar to those in claim 21. Claim 22 is similarly rejected under Ricker, Puckett, and Yang.

Answer 13-14.

3. Appellants traversed the Examiner's finding, arguing that

Claims 21 and 22 recite that translation error data of an inbound document of a trading partner is used to provide information to the trading partner based on the identified translation error data. The final office action relies on Yang to disclose this feature and cites to col. 9 of Yang and a table which is presumably the code fragment disclosed in col. 9 of Yang. However, Yang is completely irrelevant to the

features recited in these claims. The cited portion of Yang relates to a process flow in the translation of command strings in a test script and is completely unrelated to identifying translation error data from trading partner documents or to providing information to trading partners based on the identified translation error data. Accordingly, these features provide additional reasons for the patentability of claims 21 and 22.

Therefore, these features recited in the dependent claims discussed above are also not disclosed or suggested by the applied prior art and they provide additional reasons for the patentability of these claims.

Appeal Br. 7-8. Emphasis original.

C. Principles of Law

We incorporate herein the principles of law under the Principles of Law section for the rejection of claims 1-2, 6, 7, and 13-20 above.

D. Analysis

Appellants' argument (FF 3) is unpersuasive to show error in the Examiner's finding because, as with the argument regarding the rejections of claims 11 and 12, the argument focuses on whether Yang involves trading documents. However, the issue is not whether Yang anticipates the subject matter of claims 21 and 22 but whether the combination of Ricker, Puckett, and Yang would have led one of ordinary skill in the art to the subject matter of claims 21 and 22 such that it would have been obvious under 35 U.S.C. § 103(a) (2002). There is no evidence that Yang's process by which a user is notified of errors cannot be combined with the Ricker and Puckett processes. To the contrary, we find that one of ordinary skill in the art reading Yang

would understand that Yang's error notification process is useful wherever errors are detected and improvements in the system are sought.

Having found Appellants' arguments on the relevance of Puckett unconvincing, we find that Appellants have not shown error in the *prima facie* case of obviousness. The claimed steps are disclosed in the prior art. We find each step claimed performs as one of ordinary skill in the art would expect it to perform from reading the cited prior art. Each performs a known function and that function is spelled out in the prior art. The steps claimed do no more than what one would expect if the steps described in Ricker, Puckett and Yang were to be combined. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1739, 82 USPQ2d 1385, 1395 (2007). In that regard, Appellants have not shown that the claimed method yields an unexpected result.

E. Conclusion of Law

On the record before us, Appellants have failed to show that the Examiner erred in rejecting the claims over the prior art.